

REMARKS/ARGUMENTS

Claims 31-60 are pending. Claim 31 is amended to remove the word “the” thereby rendering the 112, second paragraph rejection in applicable. Claim 31 is also amended to make clearer what was already present, that is that the two structural layers include a lower and an upper layer.

While Claims 55-59 have been withdrawn from consideration they have been retained for the purpose of the Examiner rejoining the non-elected species.

The specification is amended to reference the earlier filed application to which benefit is claimed.

No new matter is added.

Substantively, the Examiner has rejected the elected claims as obvious in view of the combination of Polegato and Rechlicz. The Examiner finds that Polegato teaches an upper microporous layer among other features but does not teach that at least one of two surfaces of the upper microporous layer has a coating formed by plasma deposition treatment. See page 3 of the Action. Thus, reliance is placed on Rechlicz for their teachings pertaining to moisture vapor permeable coatings to conclude that one would have used such a coating in the construction of Polegato. Applicants respectfully disagree and note there are numerous errors in the interpretation of the claimed invention and the applied references.

First, the Examiner asserts that the upper microporous layer of claim 31 is equivalent to the upper spacing layer of hydrophobic material 222b and lower layer of hydrophilic material 222c of Fig. 3bis. However, claim 31 required before and clearly now requires that the upper layer is structural.

According to present specification at pg. 6, lines 6-10, the upper layer 15 is structural and therefore has a supporting function; in particular, it forms the foot supporting base and

has elasticity and flexibility characteristics. Such a structural function cannot be attributed to the layers of hydrophobic material 222b and hydrophilic material 222c described in Pelegato in paragraphs [0069]-[0070] as Polegato clearly identify that the functions of these layers are to increase the absorbing capabilities of the membrane 215a. Polegato does not teach that these layers have supporting structure and/or function. Rather, in paragraph [0071] the description states that the layers can be arranged in a sandwich fashion between other layers among which being supports thereby teaching that the layers alleged to be the same as the upper microporous layer in Pelagato not to be structural in of themselves.

Second, the Examiner in concluding that Polegato discloses aspects of claim 31 makes reference to Figs 1 and 3bis. The Examiner asserts that the upper microporous layer of claim 31 is equivalent to the hydrophobic material 222b and hydrophilic material 222c of Fig. 3bis and that the lower layer 13 of Fig 1 are open onto the upper layer. This interpretation is incorrect. From Fig. 3bis it is noted that hydrophobic material 222b and hydrophilic material 222c are layered on membrane 215a and protective layer 216. Thus, the layer 222b and 222c are separated from the lower layer 13 by the layers 215a and 216a. Accordingly, Polegato does not teach that the lower layer have portions that are open onto the layers 222b and 222c. Rather, Polegato teaches that the lower layer 13 has portions that open onto the protective layer 216a. Contrary to the Examiner's conclusions, Polegato does not teach that the lower layer has portions that open onto a microporous lower layer.

As to the Examiner's motivation allegation to use teachings from Rechlicz into the Pelegato structure, Applicants respectfully disagree with this conclusion as well. Polegato teaches an impermeable and breathable membrane 15, 215a that is provided within the sole. The membrane is associated and sealed, at its border, to a pre-molded insert. The skilled person would not have contemplated nor have had any reason to add a further waterproofing layer, formed by plasma deposition, to the sole of Polegato. Indeed, the Examiner has failed

to establish that either of the cited references teach plasma deposition nor is such disclosure found in the cited references.

If a further vapor permeable waterproofing layer were indeed to be added to the sole of Polegato, the overall water vapor movement and exchange through the sole would deteriorate rather than improve. One would not have considered adding a further vapor permeable waterproofing layer to the sole of Polegato which teaches to have an optimum internal climate by having heat and water-vapor exchange both through the shoe upper and through the sole. In other words, rather than teaching toward the present invention, the teachings of Polegato teach away from the features and arrangements required in the present claims. See **MPEP § 2141.02** (prior art must be considered in its entirety, including disclosures that teach away from the claims) and **MPEP § 2143.01** (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

In the rejection, the Examiner appears to equate the plasma deposited waterproof coating in the claims with the coating of hydrophobic polymer of polysiloxane of Rechlicz because Rechlicz does not teach plasma deposition nor has the Examiner cited or provided any evidence supporting the rejection that Reschlicz's coating is one made by plasma deposition nor how the manner in which Reschlicz's coating is applied inherently is the same as what is claimed. Obviousness rejections must be based on objective evidence of record. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (“ ‘The factual inquiry whether to combine references must be thorough and searching.’...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.”). The Examiner has failed to do so here. Further, if the aspect of inherency is being relied upon, as it is the burden on the Office to establish a *prima facie* case of such inherency and the Examiner does not articulate reasons why that would be so, the

rejection is flawed in this respect. Indeed, it appears that the Examiner has not considered the feature of plasma deposition as being a feature that imparts a structural distinction but this is incorrect as well. To the contrary, plasma deposition does have effects in that it allows for a control in the thickness of the waterproof coating, properties of the coating and also to have a coating which is not coupled to the upper microporous layer with glue. Thus, that the layer comprises a coating formed by plasma deposition imparts structural features not at all taught or suggested in the cited art.

As explained in the specification, the properties of the waterproof coating are not only a function of the siloxane monomers but also a function of the plasma deposition. See pg. 10, lines 10-17. Further, the breathability of the claimed sole is increased as the thickness of the coating can be controlled by the plasma deposition. See pg. 9, lines 5-7. Thus, plasma deposition can provide an ultrathin bonded layer of the polymer deposited on the upper layer.

In contrast, Rechlicz teaches that the coating is applied by hot extrusion, in solution, aqueous emulsion or in dispersion which does not provide the same precise control of the physical properties of the coating.

A further advantage of plasma deposited coating is that the adhesion between the upper layer and the coating itself is extremely strong due to the chemical interaction between the layers which occurs as a result of the plasma deposition. The coating of Rechlicz has a reduced level of adhesion strength in comparison.

Finally, Rechlicz teaches at col. 16, line 67 - col. 17, line 13 that the hydrophobic coating is used in garments or other non-structurally rigid items. The description does not provide salient teachings for including such in a shoe, which even one not of skill in the art can appreciate requires different physical properties due to the nature of how such articles are used. Accordingly, Applicants disagree that any guidance for modifying the sole in Polegato would be found in Rechlicz but for hindsight reconstruction of the present invention.

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Reply to the Official Action of June 23, 2010

After considering the above discussion, Applicants request that the rejection be withdrawn.

A Notice of Allowance is also requested.

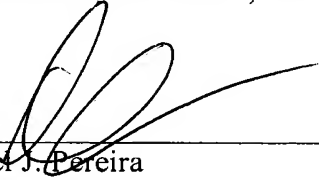
Respectfully submitted,

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